

Remarks

Claims 1-20 and 23-24 are currently pending in the Application.

35 U.S.C. §102(b) Rejection

Claims 1-3, 5-7, 9-11, 13-15, 17-20 and 23-24 stand rejected under 35 U.S.C. §102(b) as being anticipated by Sun (U.S. Patent No. 5,345,105). Applicants respectfully disagree.

The Examiner is reminded that “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” MPEP 2131 quoting *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The Examiner is also reminded that “[the] identical invention must be shown in as complete detail as is contained in the ... claim.” MPEP 2131 quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Applicants submit that the Examiner has not shown that Sun teaches each and every element as set forth in the rejected claims. In particular:

Claim 1

A. Applicants submit that the Examiner has not shown that Sun discloses, suggests or teaches, *inter alia*, at least the following features recited by Claim 1 of the present application:

“a contact region ”

According to the Examiner, the left portion of the device “10” is “a contact region” as recited in Claim 1. See page 2, lines 11-12 of the Official Action. Applicants respectfully traverse the Examiner’s assertion.

First, Applicants submit that the Examiner failed to comply with 37 C.F.R. §1.104(c)(2) which states:

“In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes invention other than that claimed by Applicant, **the particular part relied on must be designated as nearly as practicable.** The pertinence, if not apparent, must be clearly explained and each rejected claim specified” (emphases added).

Applicants submit that the Examiner has failed to “designate as nearly as practicable” the particular part of Sun relied upon in making the assertion that Sun teaches that the left side of the device “10” is a contact region. According to Sun, the left side of the device “10” contains substrate “12,” dielectric layer “14,” conductive layer “16,” dielectric layer “18,” conductive layer “20,” and dielectric layer “22.” See Figure 6 of Sun. It is not clear why the Examiner considers these layers as disclosing a contact region. Applicants request that the Examiner comply with 37 C.F.R. §1.104(c)(2) and “designate as nearly as practicable” the particular part of Sun that allegedly teaches a contact region. Otherwise, Applicants respectfully request that the assertion be withdrawn and Claim 1 be allowed.

Second, the Examiner appears to rely on facts within his personal knowledge. Applicants respectfully request, under 37 C.F.R. § 1.104(d)(2), that the Examiner provide an Affidavit supporting the Examiner’s assertions. If the Examiner is relying on a prior art reference Applicants respectfully request that the Examiner cite the reference. Otherwise, Applicants respectfully request that the assertion be withdrawn and Claim 1 be allowed.

B. Applicants submit that the Examiner has not shown that Sun discloses, suggests or teaches, *inter alia*, at least the following features recited by Claim 1 of the present application:

“field oxide layer disposed on a semiconductor substrate and within a contact region... and wherein said field oxide layer electrically isolates said metal plug contact from said contact region” (emphasis added)

The Examiner asserts that “a semiconductor substrate” recited in Claim 1 is disclosed by Sun’s substrate “12.” See page 2, line 11 of the Official Action. The

Examiner further asserts that “said field oxide layer” recited in Claim 1 is disclosed by Sun’s unmarked layer (referred to as layer “X” herein) disposed between Sun’s substrate “12” and Sun’s dielectric layer “14.” See page 2, lines 9-10 of the Official Action. The Examiner also asserts that “said metal plug” recited in Claim 1 is disclosed by Sun’s unmarked conductive layer (referred to as layer “Y” herein) disposed between Sun’s metal “16” and Sun’s layer “X.” See page 2, lines 12-13 of the Official Action. Finally, as stated above, the Examiner asserts that the left portion of the device “10” allegedly discloses “said contact region” recited in Claim 1. Applicants respectfully traverse the Examiner’s assertion.

Based on the Examiner’s assertions, “said field oxide layer electrically isolates said metal plug contact from said contact region” as recited in Claim 1 is disclosed by Sun’s layer “X” that isolates Sun’s layer “Y” from Sun’s alleged contact region. Referring to Sun’s Figure 6, the layer “X” isolates the layer “Y” from the substrate “12.” Does the Examiner consider substrate “12” to be the contact region? How can Sun’s substrate “12” be both a “semiconductor substrate” and a “contact region” as recited in Claim 1? It appears that the Examiner has misunderstood the teachings of Sun.

Applicants submit that the Examiner has not shown that Sun teaches, discloses or suggests “field oxide layer disposed on a semiconductor substrate and within a contact region... and wherein said field oxide layer electrically isolates said metal plug contact from said contact region” as recited in Claim 1. Hence, Claim 1 is patentable over Sun and should be allowed by the Examiner. Claims 2-3 and 17, at least based on their dependency on Claim 1, are also believed to be patentable over Sun.

Claim 5

Applicants submit that, at least for the reasons stated with reference to Claim 1 above, the Examiner has not shown that Sun, at least, teaches, discloses or suggests “providing a field oxide layer disposed on a semiconductor substrate and

within a contact region ...and wherein said field oxide layer electrically isolates said metal plug contact from said contact region” as recited in Claim 5. Hence, Claim 5 is patentable over Sun and should be allowed by the Examiner. Claims 6-7 and 18, at least based on their dependency on Claim 5, are also believed to be patentable over Sun.

Claim 9

Applicants submit that the Examiner has not shown that Sun discloses, suggests or teaches, *inter alia*, at least the following features recited by Claim 9 of the present application:

“a contact region ”

According to the Examiner, the right portion of the device “10” is “a contact region” as recited in Claim 1. See page 2, lines 11-12 of the Official Action.

Applicants respectfully traverse the Examiner’s assertion.

First, Applicants submit that the Examiner failed to comply with 37 C.F.R. §1.104(c)(2) by not designating “as nearly as practicable” the particular part of Sun relied upon in making the assertion that Sun teaches that the right side of the device “10” is a contact region. According to Sun, the right side of the device “10” contains substrate “12,” dielectric layer “14,” conductive layer “16,” dielectric layer “18,” conductive layer “20,” and dielectric layer “22.” See Figure 6 of Sun. It is not clear why the Examiner considers these layers as disclosing a contact region. Applicants request that the Examiner comply with 37 C.F.R. §1.104(c)(2) and “designate as nearly as practicable” the particular part of Sun that allegedly teaches a contact region. Otherwise, Applicants respectfully request that the assertion be withdrawn and Claim 9 be allowed.

Second, the Examiner appears to rely on facts within his personal knowledge. Applicants respectfully request, under 37 C.F.R. § 1.104(d)(2), that the Examiner provide an Affidavit supporting the Examiner’s assertions. If the Examiner is relying on a prior art

reference Applicants respectfully request that the Examiner cite the reference. Otherwise, Applicants respectfully request that the assertion be withdrawn and Claim 9 be allowed.

Third, the Examiner appears to be arbitrarily manipulating the teaching of Sun in order to reject the pending claims. Specifically, in rejecting Claim 1, the Examiner asserts the left side of Sun's device "10" is a contact region, however, in rejecting Claim 9, the Examiner asserts that it is the right side of Sun's device "10" is the contact region. How can that be? Does the Examiner suggest that Sun's device "10" is composed of two contact regions. Where is the support for this in Sun? Applicants request that the Examiner stop using present claims as a roadmap to manipulate the teaching of Sun in order to reject the pending claims. Applicants respectfully request that the assertion be withdrawn and Claim 9 be allowed.

Applicants submit that the Examiner has not shown that Sun teaches, discloses or suggests "a contact region" as recited in Claim 9. Hence, Claim 9 is patentable over Sun and should be allowed by the Examiner. Claims 10-11, 19 and 23, at least based on their dependency on Claim 9, are also believed to be patentable over Sun.

Claim 13

Applicants submit that, at least for the reasons stated above, the Examiner has not shown that Sun, at least, teaches, discloses or suggests "a contact region" as recited in Claim 13. Hence, Claim 13 is patentable over Sun and should be allowed by the Examiner. Claims 14-15, 20 and 24, at least based on their dependency on Claim 13, are also believed to be patentable over Sun.

35 U.S.C. §103(a) Rejection

Claims 4, 8, 12 and 16 stand rejected under 35 U.S.C. §103(a) as being obvious in view of Sun and further in view of Liu (U.S. Patent No. 6,165,861).

Applicants submit that Claims 4, 8, 12 and 16, at least based on their dependency on Claims 1, 5, 9 and 13, respectively, are believed to be patentable over Sun and Liu, because there is no prima facie 35 USC 103(a) case based on Sun, as shown above, and because the Examiner has not shown to Applicants where Liu discloses, teaches or suggests the features not found in Sun.

Conclusion

In view of the above, reconsideration and allowance of all the claims are respectfully solicited.

The Commissioner is authorized to charge any additional fees which may be required or credit overpayment to deposit account no. 12-0415. In particular, if this response is not timely filed, then the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136 (a) requesting an extension of time of the number of months necessary to make this response timely filed and the petition fee due in connection therewith may be charged to deposit account no. 12-0415.

I hereby certify that this correspondence is being deposited with the United States Post Office with sufficient postage as first class mail in an envelope addressed to Mail Stop Amendments Commissioner for Patents POB 1450, Alexandria, VA 22313-1450 on

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Respectfully submitted,

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